

REMARKS

Claims 168–194 are pending in the application and stand rejected. Claims 168, 178, and 188 have been amended. No new matter has been introduced. Reconsideration and allowance of Claims 168–194 is respectfully requested.

Interview Summary

Applicants gratefully acknowledge the telephonic interview with Examiner Dejong on June 2, 2011. The participants in the interview were Examiner Eric S. Dejong and applicants' representative, Tineka J. Quinton. During the interview, the rejections of record were discussed. Applicants thank the Examiner for his helpful comments and suggestions regarding the rejections of record; however, no agreement was reached during the interview.

The Rejection of Claims 168–194 Under 35 U.S.C. § 101 as Being Drawn to Non-Statutory Subject Matter

Claims 168–194 stand rejected under 35 U.S.C. § 101 as being drawn to non-statutory subject matter. The Examiner has taken the position that the recited process comprises only abstract steps. Applicants respectfully traverse this ground of rejection for at least the following reasons.

While not acquiescing with the Examiner's position, but solely in order to facilitate prosecution, independent Claims 168, 178, and 188 have been amended as follows.

The preamble of Claims 168, 178, and 188 have each been amended to recite, "A method for identifying a molecular target for therapeutic intervention for a second trait in a second species, the method comprising" Support for this amendment is found throughout the specification as filed, published as WO 2004/061616; for example, at page 229, lines 5–6, and page 262, lines 11–16.

Claim 168 has been further amended to recite at step (c):

determining whether a marker or a haplotype in said corresponding locus in the genome of the second species associates with said second trait, wherein, when said marker or said haplotype associates with said second trait in said second species, said locus is identified as said molecular target for therapeutic intervention, wherein at least step (c) is performed by a suitably programmed computer.

Claim 178 has been further amended to recite at step (c):

determining whether a marker or a haplotype in said corresponding locus in the genome of the second species associates with said second trait, wherein, when said marker or said haplotype associates with said second trait in said second species, said locus is identified as said molecular target for therapeutic intervention, wherein at least step (c) is performed by a suitably programmed computer.

Claim 188 has been amended to recite at step (b):

identifying a second gene in the genome of the second species that is orthologous to said first gene and in which (i) the variation of the abundance of the second gene across biological samples taken from a plurality of members of said second species and (ii) the variation of the second trait across said plurality of members of said second species are associated, wherein said second gene is identified as said molecular target for therapeutic intervention, and wherein at least step (b) is performed by a suitably programmed computer.

Support for these amendments are found in the specification as filed; for example, at page 27, line 8, to page 29, line 10.

Accordingly, removal of this ground of rejection is respectfully requested.

The Rejection of Claims 168–194 Under 35 U.S.C. § 101 for Lack of Utility

Claims 168–194 stand rejected under 35 U.S.C. § 101 for lack of utility. Applicants respectfully traverse this ground of rejection for at least the following reasons.

As noted above, in order to facilitate prosecution, independent Claims 168, 178, and 188 have each been amended to recite "a method for identifying a molecular target for therapeutic intervention." Accordingly, removal of this ground of rejection is respectfully requested.

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The Rejection of Claims 168-194 Under 35 U.S.C. § 112, First Paragraph

Claims 168-194 stand rejected under 35 U.S.C. § 112, first paragraph, for lack of enablement. The Examiner asserts that since the claimed invention is not supported by either a specific, substantial asserted utility, or a well-established utility, one skilled in the art would not know how to use the claimed invention. Applicants respectfully traverse this ground of rejection for at least the following reasons.

As described supra, in order to facilitate prosecution, independent Claims 168, 178, and 188 have been amended to recite "identifying a molecular target for therapeutic intervention." Therefore, in each of the claims as amended, the useful result is clearly stated, and the specification provides ample teaching for one skilled in the art to recognize what the result means and thus how it can be used. Accordingly, removal of this ground of rejection is respectfully requested.

Conclusion

Applicants believe that all of the pending claims are in condition for allowance. Reconsideration and favorable action are requested. If any issues remain that may be expeditiously addressed in a telephone interview, the Examiner is encouraged to telephone applicants' attorney at 206.695.1655.

Respectfully submitted,

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